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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/606,123

06/26/2003

Teruaki Shinohara

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3651

22428

7590

05/31/2005

FOLEY AND LARDNER
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EXAMINER

ROBINSON, MARK A

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

P. 2 5

Office Action Summary	Application No. 10/606,123	Applicant(s) SHINOHARA, TERUAKI	
	Examiner Mark A. Robinson	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☒ Claim(s) 4 is/are allowed.
 6) ☒ Claim(s) 1-3 and 5-13 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2872

DETAILED ACTION

Claim Objections

Claims 1-3 and 5-11 are objected to because of the following informalities: it appears that "is" is missing before "mounted" in line 17 of claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 2872

This claim stands rejected as discussed previously.

Applicant has stated that support for this limitation is found on page 9 lines 5-19 of the specification.

However, the examiner has reviewed this paragraph of the disclosure and deems it not to provide support for the limitations of claim 7. First, this paragraph only recites *positioning* which seems to imply "holding in the items in place" as opposed to any sort of rotation. Note that nowhere in this paragraph is "rotation" mentioned. Second, it is unclear which elements set forth in this paragraph correspond to the first and second mounting units of claim 7. Note that this paragraph does not provide antecedent basis for first and second "mounting units," and since rotation is not mentioned it is not possible to determine with certainty which of the elements in the specification correspond to the "mounting units" of the claim. Finally, there is no mention in this paragraph of the capability to rotate in the manner set forth in the claim. Accordingly, claim 7 is still deemed not to satisfy the enablement requirement.

Art Unit: 2872

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3,5,6,8,10 and 13 are rejected under 35

U.S.C. 102(b) as being anticipated by Iizuka (US 5610772).

Regarding claims 1 and 13, Iizuka shows a mirror apparatus including housing(20), base(30), unit bracket(22), and mirror unit(12), wherein the housing, base and unit bracket are separately formed, the housing has two openings, the base has a base portion, first mounting portion(30) for attachment to a vehicle and second mounting portion(33) on another side for mounting the unit bracket, the unit bracket has first mounting portion (the "left" side as seen in fig. 3) for mounting the housing and mirror unit and a second mounting portion (the "right" side as seen in fig. 3) protruding from the second opening in the housing and mounted to the second portion of the base and forming, along with the second mounting portion of the base, a narrow neck (see fig. 1).

Art Unit: 2872

Regarding claim 2, note that mounting axes of the base portions are near each other.

Regarding claim 3, Iizuka's mounting arrangement is shown to be "suspended."

Regarding claim 5, the interface and cooperation between the mounting portions of Iizuka are considered to constitute a "backlash prevention unit" in a similar manner as the interface between these portions of the instant invention.

Regarding claim 6, Iizuka teaches rotation in two directions in col. 2 lines 61-65.

Regarding claim 8, Iizuka teaches cooperating flat surfaces in the paragraph bridging columns 2-3.

Regarding claim 10, Iizuka shows a power unit(24) on the first mounting portion of the unit bracket.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 2872

6. Claims 7,9,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iizuka in view of either Croteau (US 5096283) or Hou (US 4998812).

Regarding claim 7, Iizuka teaches rotation in the left-right directions, but does not teach rotation in the up-down direction. However, mirror rotation arrangements for the up-down direction are well known in the art as evidenced by either Croteau (note first(26) and second(27) mounting units for up/down and left/right rotation) or Hou (note first(86) and second(881) mounting units for up/down and left/right rotation). It would have been obvious to the ordinarily skilled artisan at the time of invention to include such a rotation arrangement in Iizuka's device because of the increased adjustability (i.e. in two directions) this would provide.

Regarding claim 9, Iizuka teaches a through hole for a harness (see fig. 3), but does not teach a drain hole for draining water. However, drain holes in mirror devices are well known. It would have been obvious to the ordinarily skilled artisan at the time of invention to include a drain hole in Iizuka's mirror device to eliminate unwanted moisture from the interior of the device.

Iizuka meets the limitations of claims 11 and 12 as discussed above, but does not teach portions painted with

Art Unit: 2872

different colors. However, it is very common to use such a painting scheme on a vehicle mirror device. It would have been obvious to the ordinarily skilled artisan at the time of invention to paint the portions of the housing near the opening a different color than that of the base and unit bracket to improve the appearance of the device.

Allowable Subject Matter

7. Claim 4 is allowed.

Response to Arguments

8. Applicant's arguments filed 3/10/05 have been fully considered but they are not persuasive.

Applicant has argued that claim 7 is supported and enabled by the disclosure.

However, the 112 rejection is still appropriate for the reasons set forth above.

Applicant has also argued that Iizuka does not show the second mounting portions of the base and bracket to form a narrow neck between the housing and base.

However, these portions together form a relatively narrow portion (i.e. a neck) between the housing 20 and the base 30. This neck is not required to be separate from either the housing

Art Unit: 2872

or the base as alleged in the remarks. Attached is an annotated copy of Iizuka fig. 1 and 3 showing the neck portion.

Applicant has repeated this argument for claim 12, and thus the examiner's response is repeated.

Applicant has also argued that the mounting axes shown in Iizuka are perpendicular to each other and thus do not satisfy the limitations of claim 2.

However, it should be noted that claim 2 only requires these axes to be "near each other" which Iizuka certainly shows.

Applicant's remarks directed to claim 5 do not specifically point out any error in the examiner's interpretation of Iizuka and thus these remarks are not persuasive.

Concerning the rejection of claim 7, applicant has requested the examiner provide a reference showing the features stated to be well known.

In response, the examiner has cited two references showing these features and included these references in the rejection above as evidence of the "well known" statement.

Applicant has also stated that Iizuka does not show the features of claim 8.

However, these features are shown by the reference as noted in the previous office action. See the paragraph bridging col.

Art Unit: 2872

2-3. Note also item 20b and fig. 5 and the cooperation of the flat edges shown in figs. 6 and 7.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.

Art Unit: 2872

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

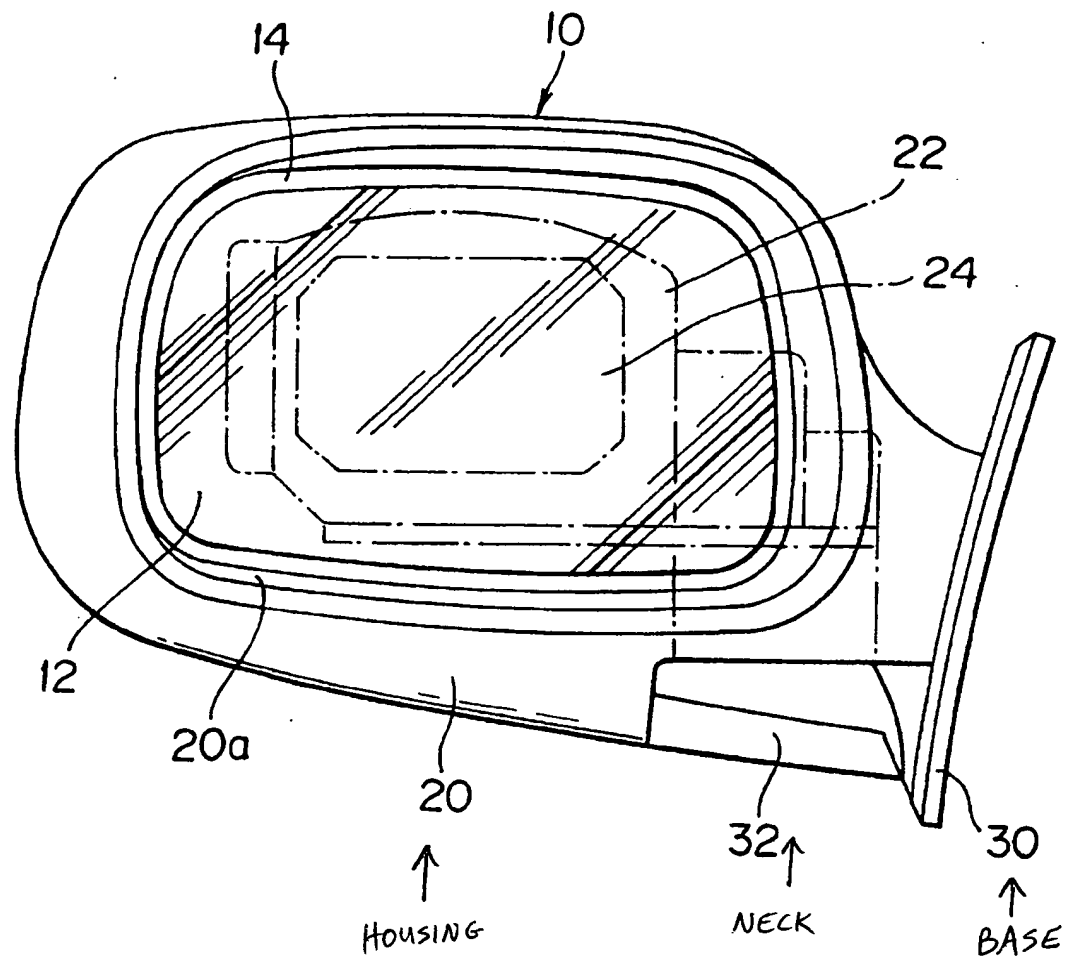
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MR

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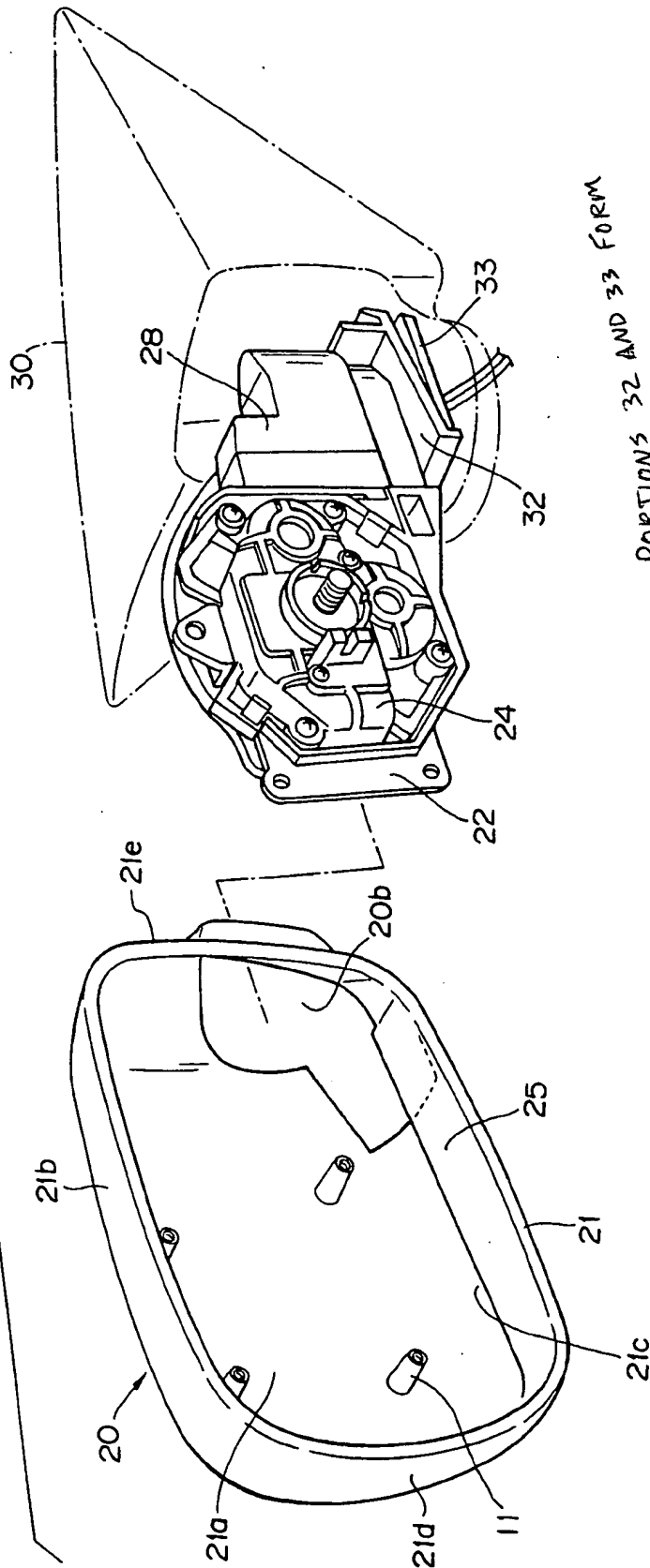

MARK A. ROBINSON
PRIMARY EXAMINER

Fig.1



10/606,123
ATTACHMENT TO
O.A. OF
5/26/05

Fig. 3



PORTIONS 32 AND 33 FORM
A "NECK" PORTION.
THIS PORTION IS BETWEEN
THE HOUSING AND THE BASE.